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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 12  
PTH

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Rene Rey Swiss Chocolates, Ltd.

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Serial No. 75/735,648

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Lalitha Mani of Perkins Coie LLP for Rene Rey Swiss  
Chocolates, Ltd.

Tracy Whittaker-Brown, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

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Before Cissel, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Rene Rey Swiss  
Chocolates, Ltd. to register the mark OUT OF THIS WORLD for  
confectionery goods, namely, chocolates.<sup>1</sup>

Registration has been finally refused by the Trademark  
Examining Attorney under Section 2(d) of the Trademark Act,

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<sup>1</sup> Serial No. 75/735,648, filed June 23, 1999; asserting a bona fide intention to use the mark in commerce and claiming a right of priority under Section 44(d) of the Trademark Act, based on the filing on a Canadian application.

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15 U.S.C. §1052(d), on the ground that applicant's mark, if used in connection with the identified goods, would so resemble the previously registered mark THEY'RE OUT OF THIS WORLD CARVEL FLYING SAUCER and design as shown below,

for "edible ice cream cones, wafers, waffles, crackers, cookies, ice creams, custards and sandwiches made from layers of wafers, waffles, crackers and cookies with

interlayers of ice creams and custards,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.

Applicant, in urging reversal of the refusal to register, argues that when the marks are viewed in their entirety, they are different in commercial impression; and that marks which include the phrase OUT OF THIS WORLD, are weak marks entitled to a limited scope of protection. In addition, applicant contends that its candy and the cookies and ice cream products listed in the cited registration are specifically different and that the respective goods are sold in distinct channels of trade. According to applicant, registrant's goods are sold only through licensed distributors.

The Examining Attorney, on the other hand, argues that applicant's mark and the registrant's mark are very similar due to the shared presence of the phrase OUT OF THIS WORLD. Further, the Examining Attorney contends that chocolates and cookies and ice cream products are related because chocolates and other candies are used as ingredients in

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<sup>2</sup> Registration No. 621,412 issued February 14, 1956; second renewal. The wording "THEY'RE OUT OF THIS WORLD" has been disclaimed apart from the mark as shown.

cookies and ice cream products. Further, the Examining maintains that goods of the type involved in this appeal emanate from the same sources. In support of the refusal to register, the Examining Attorney made of record copies of articles retrieved from the NEXIS database which make reference to ice cream products wherein chocolates, or other candies are ingredients. In addition, the Examining Attorney submitted copies of thirteen use-based third-party registrations, which show that chocolates, on the one hand, and ice cream products and/or cookies, on the other hand, may emanate from the same source under the same mark.

Turning first to the respective goods, we must determine the issue of likelihood of confusion based on the manner in which the goods are set forth in the application and the cited registration, respectively. In the absence of any limitations in applicant's application and the cited registration, we must presume that applicant and registrant's goods move in all channels of trade normal for such goods, which would include grocery stores, convenience stores, and mass merchandisers. Thus, for purposes of our analysis, we must assume that the goods would move in the identical channels of trade to the same class purchasers, namely ordinary consumers.

We recognize that chocolates are different in nature from cookies and ice cream products. It is not necessary, however, that goods be identical or even competitive in nature to in order to support a finding of likelihood of confusion. It is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that would give rise, because of the marks used thereon, to the mistaken belief that they originate from the same source. See *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In this case, the evidence made of record by the Examining Attorney establishes that chocolates and cookies and ice cream products are sufficiently related that if they were sold under identical or substantially similar marks, confusion would be likely to result.

Turning next to the marks, although they share the phrase OUT OF THIS WORLD, we find that there are specific differences between applicant and registrant's marks. In particular, the wording CARVEL FLYING SAUCER and the prominent ice cream sandwich design in registrant's mark results in a mark that, when considered in its entirety, is different in appearance, sound and commercial impression from applicant's mark OUT OF THIS WORLD. Moreover, the phrase THEY'RE OUT OF THIS WORLD is used in registrant's

mark as a tag line and it is the words CARVEL FLYING SAUCER, which are more likely to be noted by consumers as signifying the source of registrant's goods.

Applicant, in support of its argument that marks which include the phrase OUT OF THIS WORLD are weak marks and entitled to a limited scope of protection, submitted a list of third-party registrations which include the phrase in its request for reconsideration. As noted by the Examining Attorney, the submission of a mere list of registrations is not the proper way to make the registrations of record. In order to make registrations of record, copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's database, must be submitted. See *Weyerhauser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Thus, in reaching our decision herein we have not considered the list of registrations. However, we judicially notice that the Dictionary of American Slang (1995) defines the phrase "Out of this World" as "Excellent; wonderful; superior =*the greatest, way out.*" It is clear that the phrase is a laudatory designation and it is well settled that the addition of other matter to a laudatory designation may be sufficient to avoid confusion. See *King Candy Company v. Eunice*

King's Kitchen, Inc., 178 USPQ 121 (TTAB 1973). In this case, where one mark consists of a laudatory designation and the other mark consists of the identical laudatory designation in addition to other wording and a design element, we find that the other wording and the design element are sufficient to avoid confusion.

In sum, in view of the differences between registrant's mark THEY'RE OUT OF THIS WORLD CARVEL FLYING SAUCER and design and applicant's mark OUT OF THIS WORLD, we find that there is no likelihood of confusion in this case, notwithstanding the relatedness of the involved goods.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is reversed.

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